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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/762,232	02/05/01	MIGNAULT L	82223-202

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EXAMINER	
WILLIS,M	
ART UNIT	**PAPER NUMBER**
1619	5

AIR MAIL

DATE MAILED: 07/30/01

Please find below and/or attached an Office communication concerning this application r proceeding.

Commissioner of Patents and Trademark

Office Action Summary	Application No.	Applicant(s)	
	09/762,232	MIGNAULT, LORRAINE	
	Examiner	Art Unit	
	Michael A. Willis	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 May 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 17-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 17-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 1-11 and 17-22 are pending.

Information Disclosure Statement

1. The information disclosure statement filed 7 May 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because three of the listed references do not have dates of publication. The references lacking publication dates not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows: An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-8 and 21-22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 2, 7, and 21 are rejected due to the term "magnetized". It is unclear what is meant by the term, especially in connection with water.

6. Claim 8 is rejected due to the term "topologically". The examiner respectfully suggests the term "topically".

7. Any remaining claims are rejected for depending from indefinite base claims.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the specification fails to enable the skilled artisan to practice the invention without undue experimentation. As held by *ex parte Forman* (230 USPQ 546, BdPatApp & Int.) and *In re Wands* (8 USPQ 2d 1400, CAFC), there are several guidelines when determining if the specification of an application allows the skilled artisan to practice the invention without undue experimentation.

Amount of guidance present: The specification fails to provide any guidance for preventing or stopping hair loss.

Absence of working example: The specification fails to provide any working examples relating to preventing or stopping hair loss in the instantly claimed methods.

Nature of invention: The nature of the invention is a topical lotion comprised of an aqueous extract of oatstraw. However, the claim of preventing and stopping hair loss does not seem to fit in with the nature of the invention. It is not clear how the lotion can be used in the instantly claimed methods, given the formula present, due to its described use as a lotion for pain treatment or a laundry additive.

State of the prior art: The state of the prior art of hair loss prevention is not well understood. Oatstraw extract is not recognized in the state of the prior art.

Relative skill of those in the art: Those in the art would not be able to practice the instantly claimed method with an aqueous extract of oatstraw, since this would amount to undue experimentation to test which possible formulations are useful.

Unpredictability in the art: Given the diversity of treatments of hair loss and the general lack of use of oatstraw, it would be very unpredictable to use aqueous extracts of oatstraw in the instant claimed methods.

Breadth of claims: The claims are broad, wherein hair loss is stopped.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to

make and/or use the invention. In particular, the specification fails to enable the skilled artisan to practice the invention without undue experimentation. As held by *ex parte Forman* (230 USPQ 546, BdPatApp & Int.) and *In re Wands* (8 USPQ 2d 1400, CAFC), there are several guidelines when determining if the specification of an application allows the skilled artisan to practice the invention without undue experimentation.

Amount of guidance present: The specification fails to provide any guidance for the protocol required for the treatment of pain, swelling, itching or inflammation.

Absence of working example: The specification fails to provide any working examples relating to the treatment of pain, swelling, itching or inflammation in the instantly claimed methods.

Nature of invention: The nature of the invention is a lotion comprised of an aqueous extract of oatstraw. However, the claim of a treatment for psoriasis, leprosy, etc. does not seem to fit in with the nature of the invention.

State of the prior art: Treatment for the symptoms of psoriasis, leprosy, etc. is not well understood, and a lotion from an aqueous extract of oatstraw is not recognized in the state of the prior art.

Relative skill of those in the art: Those in the art would not be able to practice the instantly claimed method with a lotion of an aqueous extract of oatstraw, since this would amount to undue experimentation to test which possible concentrations of ingredients and application protocols are useful.

Unpredictability in the art: Given the diversity of conditions listed in the claims and the general lack of use of aqueous oatstraw extracts in topical lotions, it would be very unpredictable to use aqueous oatstraw extracts in the instantly claimed methods.

Breadth of claims: The claims are broad, wherein the symptoms of psoriasis, leprosy, skin poisoning, shingles, measles, chicken pox, boils, cold sores, colds and flu, sinus congestion, sun damage, burns, sunburns, menstrual bloating, menstrual cramps, acne, foot pain, eczema, rosacea, dermatitis, insect bites, parasitic infections, herniated discs, back and/or leg spasms, sore or damaged muscles, ligaments and tendons, bruising, varicose veins, fibromyalgia, multiple sclerosis, cancer treatments, internal organ injuries, brain and nerve surgery, and arthritis are treated.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-7 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kasimtsgva et al (Derwent Acc. No. 1993-402391; Abstract of SU 1776407) in view of Kovacs (US Pat. 4,886,665).

11. Kasimtsgva teaches a face cream which does not irritate or sensitize the skin. The cream contains aqueous alcoholic glycerinic oat extract, lavender extract, and glycerin. The reference is silent with regard to a procedure for the extraction of oats.

12. Kovacs teaches a method of extracting oat leaves. The oat leaves are passed through a food chopper and then treated in hot distilled water for a period of time (see col. 2, lines 12-20).

13. It would have been obvious to one of ordinary skill at the time the invention was made to have used of the extraction technique as taught by Kovacs in order to obtain an extract of oats for use in the composition with non-irritating properties as taught by Kasimtsgva.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Juliano et al (US Pat. 4.014,995) discloses cosmetics containing finely divided oat flour. The cosmetics are derived from oat flour rather than aqueous extracts of oatstraw. Kemp (US Pat. 5,152,989) discloses a bath additive and its use. The bath additive is comprised of a glycol extract of oatstraw, rather than an aqueous extract of oatstraw.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on Mon. to Fri. from 9 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2742 for regular communications and (703) 308-2742 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Michael Hartley
Primary Examiner

Michael A. Willis, Ph.D.
Patent Examiner
Art Unit 1619

July 27, 2001